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IN THE

Supreme Court of the United States

October Term, 1951

No. 290

PHOTOCHART, a Corporation, and LORENZO DEL RICCIO,
Petitioners,

v.

PHOTO PATROL, INC., a Corporation; PACIFIC TURF CLUB, INC., a Corporation; AMERICAN TELETIMER CORPORATION and ROBERT OSWALD,
Respondents.

BRIEF OF RESPONDENTS IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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The Petition Sets Forth No Adequate Reason for Granting the Writ.

"This is an ordinary patent case." Thus this court in the case of *Layne & Bowler Corporation* v. *Western Well Works, Inc., et al.*, 261 U. S. 387, 388, introduced its decision. The grounds upon which certiorari should be granted were stated at page 393:

> "* * * it is very important that we be consistent in not granting the writ of certiorari except in cases involving principles the settlement of which is of importance to the public as distinguished from that

> of the parties, and in cases where there is a real and embarrassing conflict of opinion and authority between the circuit courts of appeal. The present case certainly comes under neither head."

The two conditions were restated in *Magnum Import Co., Inc.* v. *Coty*, 262 U. S. 159, 163:

> "The jurisdiction was not conferred upon this court merely to give the defeated party in the Circuit Court of Appeals another hearing."

In the present case neither of the two conditions for granting the writ of certiorari is present. There is no conflict with any decision of any other Court of Appeals and there is no question of public interest involved. As a matter of fact the sole point raised by the petition is complaint that the District Court and the Court of Appeals for the Ninth Circuit held claims 1, 2, 7 and 8 of Reissue Letters Patent No. 22,881 invalid.

It should be emphasized that the District Court found and decreed not only that the claims were invalid, but also that they had not been infringed by respondents. (R. 71, 72, 75, 87, 90, 91, 101) Thus, even as between the parties litigant, a holding that the claims in suit are valid, rather than invalid, would not alter the fact that the ultimate judgment must be entered for respondents. Hence, as far as public interest is concerned, this petition raises not a ripple. Further, the petition presents no special or important reasons why the writ should be granted.

This is an ordinary patent case involving the sole question of validity of four claims of a reissued patent. The following statement by this Court in *Keller* v. *Adams-Campbell Co.*, 264 U. S. 314, 317 is, therefore, controlling:

> "Such an ordinary patent case, with the usual issues of invention, breadth of claims, and non-infringement, this court will not bring here by certiorari unless it be necessary to reconcile the decisions of circuit courts of appeal on the same patent."

Reasons Relied Upon by Petitioner Insufficient to Justify the Writ of Certiorari.

The petitioners complain of injustice resulting from the judgments below and assert that a serious question of public importance is involved. The serious question of public importance is said to be that the United States Court of Appeals for the Ninth Circuit misconstrued the decision of this Court in *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Co.,* 340 U. S. 147, as announcing a new and more severe test of invention.

Actually the Court below relied upon several other decisions of this Court in addition to *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Co., supra,* which control the outcome of the holding of invalidity. Thus the Court of Appeals for the Ninth Circuit stated (R. 526):

> "The test to be applied to such patents is that the combination must perform some new or different function—one that has unusual or surprising consequences. It is our view that the patent in suit fails to meet this severe test and does not constitute invention. The most that can be said for the patent in suit is that it rearranges the elements of the slit camera in such a manner that in the performance of their respective functions a higher degree of accuracy is obtained. But perfection of workmanship, however useful or convenient, does not constitute invention. Cuno Corp. v. Automatic Devices Corp., 314 U. S. 84; Dow Chemical Co. v. Halliburton Oil Well Cementing Co., 324 U. S. 320; * * *."

The District Court decided this case in favor of respondents before the opinion in the *Supermarket* case was announced.

The litigation has run its gamut. The District Court in its judgment (R. 61-64) 89 Fed. Supp. 198, adjudged the subject claims to be invalid for lack of invention and

not infringed. The petitioners moved for a new trial and after a full hearing the motion was denied (R. 100). Petitioners appealed to the Court of Appeals for the Ninth Circuit and that Court affirmed the District Court (R. 520-530), 181 Fed. 2d 625. Petitioners' petition for rehearing was denied (R. 531). The petition to this Court is merely a complaint that the litigation has not been successful so far as petitioners are concerned.

CONCLUSION

Respondents submit that the petition for the writ of certiorari should be denied.

Respectfully submitted,

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Respondents.

Petition for Rehearing of Petition for Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit.

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Respondents.

Petition for Rehearing of Petition for Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit.

To the Honorable, the Chief Justice of the United States and the Associate Justices of the Supreme Court of the United States:

On August 30, 1951, your petitioners, Photochart, a corporation, and Lorenzo del Riccio, plaintiffs-appellants below, filed Petition for Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit, to review a judgment of that Court [R. 530] entered June 11, 1951, affirming a judgment in a patent case [R. 87] holding invalid claims 1, 2, 7 and 8 of the United States Reissue Letters Patent No. 22,881 [R. 393].

Said petition was denied by this Court on November 5, 1951. The time within which Petition for Rehearing may be filed herein was extended to December 10, 1951, by order of this Court.

Your petitioners now respectfully petition for a rehearing of said Petition for Writ of Certiorari.

Jurisdiction.

Jurisdiction of this Court is based upon Section 1254 of Title 28, U. S. C. A. Petition for rehearing is authorized by Rule 33 of this Court.

Statement.

The patent in suit teaches a method of so correlating the elements of a slit camera with a fixed line (such as the finish line of a race course) as to overcome the old and serious problem of "angular viewing" in photographing a number of objects (such as race contestants) moving side by side past such fixed line. The patented method was the first to eliminate all margin of error in photographing the finish of a track event, although all the elements of the slit camera had been before the art for 37 years.

In its opinion [R. 520], the court below not only recognized the novelty of the patented method over the prior art, but also recognized that it produced an improved result. However, the Court's decision appears to have been based upon its view that this Court's opinions in *Great Atlantic & Pacific Tea Co. v. Supermarket*

Equipment Corp., 340 U. S. 147; *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U. S. 84; *Toledo Co. v. Standard Parts*, 307 U. S. 350, announced a new doctrine, to the effect that where a combination produces merely an improved result as distinguished from a new and different function, it is unpatentable. In arriving at this conclusion, the Court below appears to have misconstrued this Court's opinions, in the above identified cases, as being intended to overrule this Court's former decisions upholding patentability of inventions which produced only improved results as distinguished from new and different functions.

New Question Presented by This Petition.

The opinion and judgment below therefore raise this substantial question:

> "Did this Court, by its opinions in *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U. S. 147; *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U. S. 84; *Toledo Co. v. Standard Parts*, 307 U. S. 350 overrule its prior decisions holding that an improved result as distinguished from a new and different function was sufficient to sustain a patent?"

While this question was availabe for presentation in the original Petition for Writ of Certiorari, it was not raised because petitioners felt that the questions presented were adequate to warrant issuance of the writ.

Additional Reasons for Allowance of Petition.

If the court below was wrong in construing the intent of this Court's opinions, and petitioners submit that it was in error, not only does the opinion below constitute an extremely dangerous precedent, but, unless corrected, it will result in a grave injustice to petitioners.

The patent statute (35 U. S. C. 31) has always provided that anyone who invents or discovers "any new and useful *improvements*" in any art, machine, manufacture, or combination of matters, is entitled to a patent.

This Court has always held that a meritorious invention or discovery which produces a useful, improved result as distinguished from an entirely new and different function, is patentable.

> *Eibel Process Co. v. Minnesota & Ontario Paper Co.*, 261 U. S. 45;
>
> *Keystone Mfg. Co. v. Adams*, 151 U. S. 142.

For instance, in *Eibel Process Co. v. Minnesota & Ontario Paper Co., supra*, the patentee improved paper making machinery merely by elevating one of the elements to take greater advantage of gravity flow. Although each element of the machine continued to perform in its same old way, the invention increased the capacity of the machine by at least 25%, and this Court sustained the patent as a substantial advance in the art. It is not believed that this Court intended, by its later decisions above mentioned, to overrule its prior decisions, which were clearly in accordance with the language and intent of the patent statute.

Wherefore, Your Petitioners Pray that a rehearing be granted and that the Petition for Writ of Certiorari be issued.

Respectfully submitted,

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I hereby certify that this petition is presented in good faith and not for delay and that the same is restricted to a ground deemed to be substantial and which, although available, was not previously presented as a reason for grant of the Petition for Writ of Certiorari prayed for.

COLLINS MASON.